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In re Application of:  
CATTON, Piers, et al. : DECISION ON PETITION UNDER  
U.S. Application No.: 10/540,174 : 37 CFR 1.47(a)  
PCT No.: PCT/DE03/04087 :  
Int'l Filing Date: 11 December 2003 :  
Priority Date: 18 December 2002 :  
Atty Docket No.: CATTON,P.ET AL – 1 PCT :  
For: INTAKE MANIFOLD AND :  
ASSOCIATED PRODUCTION :  
METHOD :  
:

This decision is issued in response to applicants' petition under 37 CFR 1.47(a) filed 28 November 2005.<sup>1</sup> Applicants have submitted \$130 as the petition fee; however, the correct petition fee is \$200. Deposit Account No. 03-2468 will be charged the remaining \$70.

### BACKGROUND

On 11 December 2003, applicants filed international application PCT/DE03/04087. The application claimed a priority date of 18 December 2002 and designated the United States. On 01 July 2004, the International Bureau (IB) communicated a copy of the international application was communicated to the United States Patent And Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 18 June 2005.

On 17 June 2005, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and a translation of the international application into English.

On 26 September 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) requiring submission of an oath or declaration in compliance with 37 CFR 1.497 and the surcharge for filing the oath or declaration later than thirty months after the priority date.

On 28 November 2005, applicants filed a response to the Notification Of Missing Requirements which included payment of the required surcharge, a declaration executed by one

<sup>1</sup> It is noted that the petition and accompanying materials were directed to application number 10/504,174; however, based on bibliographic information and content of the materials (including the attached copy of the Form PCT/DO/EO/905), the submission has been placed in the present application file, application number 10/540,174.

of the two inventors, and the petition under 37 CFR 1.47(a) considered herein. The petition seeks acceptance of the declaration without the signature of the remaining inventor Piers CATTON, whom applicants assert cannot be located after diligent effort.

## DISCUSSION

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the nonsigning inventor; (3) an oath or declaration executed by the other inventors on behalf of themselves and the nonsigning inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Applicants here have submitted a portion of the petition fee (Deposit Account No. 03-2468 will be charged the remaining amount) and the petition expressly states the last known address of the nonsigning inventor. Items (1) and (2) are therefore satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicants have filed a declaration that appears to have been executed by one of the named inventors on his own behalf and expressly on behalf of the nonsigning inventor, Piers CATTON. However, the declaration submitted is illegible in parts. Before the present declaration can be accepted, a fully legible copy of the document must be submitted, so that it can be confirmed that the declaration includes all required statements. Accordingly, item (3) is not satisfied on the present record.

Regarding item (4), the petition asserts that the nonsigning inventor cannot be reached or located after diligent effort. Section 409.03(d) of the MPEP states the following concerning such cases:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. ....

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein.

Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support

a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

Here, applicants have submitted a "Statement Of Facts" executed by Stefan Jauss. The statement refers to "former actions" that purportedly demonstrate that the inventor is not reachable at his last known address. However, no details regarding these "former actions" are provided, so it is not clear whether these actions are sufficient or whether Mr. Jauss is the person who performed the earlier actions (and therefore has the requisite first hand knowledge of such efforts). In addition, no documentation of such efforts is provided (i.e., copies of returned envelopes, etc.). The statement also refers to an unanswered email (a copy of which has not been provided) and non-specified further "inquiries" regarding the inventor's address.

On the present record, item (4) is not considered satisfied. Without further details, it cannot be determined whether applicants have made a diligent effort to locate the nonsigning inventor. Applicants must supplement the present petition with a firsthand statement that describes specifically the actions taken to locate and contact the nonsigning inventor. This statement should be supported, where appropriate, by documentary evidence. Any such submission should include evidence that an internet search to locate the inventor was conducted, with a copy of the results of such search being provided.

### CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include a legible copy of an acceptable declaration, and the firsthand and documentary evidence required to demonstrate that a diligent effort has been made to locate the nonsigning inventor, as discussed above. Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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